



Paper No. 6

COPY MAILED

NOV 08 2000

PAUL A ROBERTS
1133 19TH STREET NW
WASHINGTON, DC 20036

In re Application of
Stone and Sibley
Application No. 09/469,505
Filed: 22 December, 1999
Attorney Docket No. UUN99006

: OFFICE OF PETITIONS
: A/C PATENTS
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:
:

This is in response to the petition under 37 CFR 1.47(a), filed on 10 April and supplemented by facsimile on 12 May, 2000.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on 22 December, 1999, without an executed oath or declaration.

Accordingly, on 7 February, 2000, a "Notice To File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on 4 June, 1999, petitioner filed, *inter alia*, the instant petition under 37 CFR 1.47(a), and (a) authorization to charge counsel's deposit account for the required surcharge and petition fee, (b) an unsigned oath or declaration, (c) a facsimile transmittal page purporting to transmit the assignment and declaration for the above-referenced patent application to joint inventor Sibley.

Petitioner asserts that the assignment and Declaration for the present application was sent to the non-signing inventor. The inventor, however, has refused to sign and return the Declaration.

Application No. 09/469,505

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The instant petition lacks items (1) and (2).

In regards to item (1), petitioner has not provided proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) was sent or given to the non-signing inventor for review.¹ Petitioner states merely that a copy of the assignment and declaration were forwarded to the non-signing inventor. Petitioner must send or give a copy of the entire application as filed to the non-signing inventor. A copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Additionally, petitioner must submit proof of the inventor's refusal to sign. If there is a written refusal, petitioner must present a copy of the written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or a declaration of facts.

In regards to item (2), the declaration presented is not acceptable because it must be signed by the joint inventors who have not refused to sign. The declaration is acceptable if all of the signing inventors signed in their respective signature blocks and the signature block of the non-signing inventor is left blank or all of the signing inventors sign a statement stating that they are signing on behalf of the non-signing inventor. Additionally, the oath or declaration must state both the residence and post office addresses for each inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

¹MPEP 403.03(d).

Application No. 09/469,505

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy